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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,908	11/28/2000	Casey J. Pelkey	723-987	7830

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EXAMINER

ENATSKY, AARON L

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 09/27/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/724,908

Applicant(s)

PELKEY ET AL

Examiner

Aaron L Enatsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 10-28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 10 and 28 require that a messaging service is accessible during the execution of a video game program, wherein the video game system is in a non-multi-taking mode. If the video game system is in a non-multi-tasking mode, then only one program or task can run at any one time, similar to the operation of MS-DOS where, only one program could run at any one time. Accessing another program, meant that the current running program must be closed, hence a non-multi-tasking system.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 requires that the use of buddies and a buddy list, neither of which is defined.

Claim Rejections - 35 USC § 102

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1-3, 5, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by First Internet Backgammon Server 1994 (FIBS). FIBS teaches an Internet connected server (Pg. 1, What is FIBS?), a plurality of people connecting to the Internet server indicating at least two video game systems configured to connect (Pg. 1, What is FIBS?), communicating status data of activity through watching plays (Pg. 2, Player status), session data on status of users concerning their ratings and availability (Pg. 2, Player status), and the session data is available to anyone logged into the system regardless of game play.

In re claim 2, FIBS teaches indicating status data of whether a player is online (Pg. 2, Player status) and where the ability to send and receive message is inherent once online.

In re claim 3, FIBS teaches indicating status data of whether a player is online (Pg. 2, Player status) and setting an indicator of status to 'not ready', which indicates a player is online, but not ready to communicate or play a game.

In re claim 5, FIBS teaches storing player profiles as rating, experience, and game drop ratings (Pg. 2, Player status; Pg. 3, Droppers).

In re claim 7, FIBS teaches an administrator blocking a user's access effectively affecting the accessibility of a user profile.

Claim Rejections - 35 USC § 103

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 10-13, 16-18, 22, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over FIBS. FIBS teaches the claimed limitation as discussed above in addition to the chat software contemporaneously with the game, but does not teach the application stored on a portable memory medium. However, as is old and well known in the computing arts, storing programs for portability on optical, magnetic, or semiconductor medium can be accomplished and are all considered art recognized equivalents. One would be motivated to store the game program on a portable memory medium for distribution to a wider audience that does not have high bandwidth network access, often a limitation for downloading large files. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify FIBS to include the game software on a portable memory medium for greater access by the public, therefore increasing game participation and distribution.

In re claim 16, FIBS teaches the game used the Internet for communication as described by the game server title.

In re claims 17 and 18, FIBS teaches a user registration routine in the messaging and game software, where the registration will create a user profile (Pg. 2, Username and password).

In re claim 22, FIBS teaches having a buddy list routine for creating buddy list as described by the ability to find out who is currently logged on (Pg. 2, Player status).

In re claim 28, FIBS teaches the portable memory storage as discussed above, and furthermore teaches the game executed on a computer device. As a computer would typically have inputs for the various memory mediums, it would have been obvious to one of ordinary skill to have connectors connecting the drives that read the memory medium to the computer for necessary read/write operations.

9. Claims 4, 6, 8, 9, 19, 20-21, 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over FIBS in view of Instant Messaging Guide 1996 (IMG).

In re claim 4, FIBS teaches the claimed limitations as discussed above, but does not teach indicating a users ability to send, but not receive. IMG discloses Internet chatting programs and their features, where a user can customize a message to indicate anything the users wants to share with other users. FIBS and IMG are related in that both facilitate network real-time messaging between available users. IMG is an updated chatting program having features that are highly desirable to most users attempting to use real-time chatting, therefore providing motivation to include these features in FIBS. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify FIBS to include a user customizable indicator of availability, which would allow a user to let others know that they are able to send but not receive messages.

In re claim 6, FIBS in view of IMG teaches blocking access to a users profile as one of the message indicators.

In re claim 8, FIBS in view of IMG teach the claimed limitations as discussed above, but do not teach communicating to a user the buddy list memberships a user is active in. IMG teaches providing security measures to let users know what buddy lists they belong to through

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authorization techniques. A first user cannot be added to a buddy list of a second user unless the first user provides authorization through a notification request from a second user (Pg. 6, ICQ (I Seek You)). One would be motivated to modify FIBS in view IMG to add the buddy list membership identifier, to increase system security, and it bars people you don't want to talk to from instant messaging you. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify FIBS in view of IMG to further add a buddy list membership identifier as part of system software for security purposes.

In re claim 9, FIBS in view of IMG teach the claimed limitations as discussed above, where denying authorization to add one to a buddy list is analogous to a request for deleting that user's name from the buddy list.

In re claim 19, FIBS in view of IMG teach the claimed limitations as discussed above in claim 6.

In re claims 20-21, FIBS in view of IMG teach the claimed limitations as discussed above, but does not teach having the ability to add customized images to a user profile. IMG teaches allowing a user to add customized images in the user's profile (Pg. 3, Sending & Receiving Instant Messages). One would be motivated to add the customized image feature in the game system taught by FIBS in view of IMG to allow a user to easily identify the other party participating in communication or game play, thus providing further security. The customized image would include any image, including a digital image of the user. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify FIBS in view of IMG to include the customized image of another user while in communication to allow for easier identification of the other user.

In re claim 23-24, FIBS in view of IMG teach the claimed limitations as discussed above, but does not teach providing alerts during a sign-on or sign-off event. IMG teaches of alerting a user for when another user is on or off line (Pg 2, The Contact List; Fig. 1). One would be motivated to modify FIBS in view of IMG to include the alert feature so that a user can be automatically notified of the presence or absence of a particular user for game play or chatting. A user may only want to contact or play with an acquaintance, rather than a complete stranger. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify FIBS in view of IMG to include the feature of sign-on/sign-off alerts so that a user will be automatically notified of the presence/absence of another particular game player that a user wishes to play/contact.

In re claim 25, FIBS teaches an alert when a message arrives, as the message itself is the alert, for example, when inviting a player to a game or chatting (Pg 2, Player status, Chatting).

In re claim 26, FIBS in view of IMG teach the claimed limitations as discussed above, but does not teach an auto start and auto logging routine for the game program. IMG teaches an auto-start and logging routine when starting a users computer (Pg. 3, The Good and the Bad). One would be motivated to modify FIBS in view of IMG to include the auto-start and logging feature to alleviate a user from manually starting the game/messaging program, where it is obvious to automate a manual process. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify FIBS in view of IMG to include the auto-start and logging feature, to have the game software program instantly ready for a user to participate, adding increased play time.

In re claim 27, FIBS in view of IMG teach customizing a message describing a user's activity as discussed in claim 4, which would also allow a user to log that particular activity the user is engaged in on the computer system.

10. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over FIBS in view of IMG and further in view of Best '073. FIBS in view of IMG teach the claimed limitations as discussed above, but do not teach the game system comprising a hand-held or video game console. Best teaches a communicative game system using a handheld game system and a video game system to play a (Fig. 9), both of which can accept portable memory storage mediums (9:63-10:14). FIBS in view of IMG and Best are related as game system played by multiple players, facilitating communication between participating players where one would have been motivated to use the game video game console or the handheld game system to play the game, as a specialized hardware for a singular purpose is less expensive than employing the use of a general purpose computer. A general-purpose computer is more expensive due to the need for greater functionality, wherein the handheld system or the console system need only serve the purpose set forth by the game constraints. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made modify FIBS in view of IMG to use either the handheld or video console game system, to help reduce game costs, therefore increasing marketability, player usage.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sparks, II '479, discloses an online interactive community and game system, facilitating communication between remote players.

For Instant Success, Add Instant Messaging 1999, teaches AOL instant messenger providing an application programming interface (API) for connection AOL with other programs.

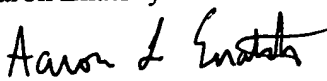
Ad potential driving messaging war 1999, teaches advertising in instant messaging clients providing a driving force behind increasing instant messaging usage.

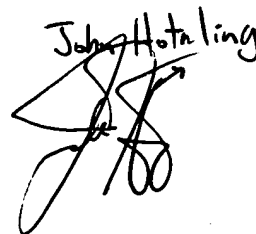
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron L Enatsky whose telephone number is 703-305-3525. The examiner can normally be reached on 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Aaron Enatsky


September 19, 2002


John Hotaling